

Remarks:

Status of Claims

Claims 2-5, 7-11, and 13-16 are canceled without prejudice or disclaimer, such that claims 1, 6, 12, and 17-20 are currently pending in the application.

Remarks

The present application is a continuation of an earlier-filed parent application. An Office Action, dated April 8, 2003, issued in the parent application in which the Examiner:

rejected claims 1 and 3 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,035,606 (hereinafter referred to as "Browder") in view of U.S. Patent No. 6,201,474 ("Brady");

rejected claims 4-6, 11, 12, and 14-16 under 35 U.S.C. §103(a) as being unpatentable over Browder in view of Brady and further in view of Japanese Patent No. JP 6-124778 ("Inoue") or U.S. Patent No. 6,232,585 ("Clothier"); and

objected to claims 2, 7-10, and 13 as being dependent upon a rejected base claim but allowable if rewritten in independent form.

In response to this Office Action, claims 1, 6, and 12 were canceled from the parent application without prejudice or disclaimer. The present continuation application pursues further prosecution of these claims.

The Applicant respectfully disagrees with the Examiner's previous rejection of claim 1 under 35 U.S.C. §103(a) as being unpatentable over the combined teachings of Browder and Brady. Brady is non-analogous art with the regard to the present invention and therefore cannot properly be used in rejecting claims to the present invention.

The applicable test for determining whether a prior art reference is properly analogous with respect to an invention involves:

- (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the same field of the inventor's endeavor, whether the reference still is reasonably pertinent to the

particular problem with which the inventor is involved. *In re Clay*, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992).

An invention cannot be considered to be within the field of endeavor of a prior art reference merely because both relate to the same industry. *Id.* 1060. However, “[a] reference is reasonably pertinent if, even though it may be in a different field from that of the inventor’s endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to the inventor’s attention in considering his problem”. *Id.* 1061. Patent examination, however, is necessarily conducted by hindsight, with complete knowledge and benefit of the applicant’s invention as a guide. *In re Oetiker*, 24 USPQ2d 1443, 1447 (Fed. Cir. 1992). For this reason, it is necessary to consider the “reality of the circumstances” in deciding in which fields a person of ordinary skill in the art would reasonably be expected to look for the solution to the problem facing the inventor. *Id.* 1447. Ultimately, a rejection based on non-analogous art cannot be sustained. *Id.* 1061.

The test set forth in *In re Clay* was tellingly applied, for example, in *Wang Laboratories, Inc. v. Toshiba Corp.*, which is cited by and discussed in MPEP §2141.01(a) in the context of determining analogousness in the electrical arts. *Wang Laboratories, Inc. v. Toshiba Corp.*, 26 USPQ2d 1767 (Fed. Cir. 1993). Wang Laboratories, Inc. (hereinafter referred to as “Wang”), as assignee, brought suit against a number of parties, including Toshiba Corp. and NEC Corp., for infringement of U.S. Patent Nos. 4,656,605 (the “605 patent”) and 4,727,513 (the “513 patent”). *Id.* 1070. These patents relate to and claim certain types of single in-line memory modules (SIMMs) (the “Wang SIMMs”). *Id.* 1770. At trial, a jury found that SIMMs manufactured by Toshiba Corp. and NEC Corp. infringed certain claims of the ‘605 and ‘513 patents. *Id.* 1770. In relevant part, Toshiba Corp. and NEC Corp. moved for JNOV, which was denied, and thereafter appealed. *Id.* 1770.

On appeal, Toshiba Corp. and NEC Corp. argued that the claims at issue were invalid for obviousness under 35 U.S.C. §103 in light of U.S. Patent No. 4,281,392 to Allen-Bradley Co. and its commercial counterpart the X9 SIMM (the “Allen-Bradley SIMM”). *Id.* 1772. Toshiba Corp. and NEC Corp. argued that the Allen-Bradley patent and the Allen-Bradley SIMM were analogous to the claimed subject matter and effective to render the relevant claims of the ‘605 and ‘513 patents invalid. *Id.* 1772.

The court held that an adequate jury instruction regarding analogous art had been provided at trial, and held that the jury's finding of non-analogous art was supported by substantial evidence. *Id.* 1773. Specifically, the court cited the criteria set forth in *In re Clay*, and noted that "[t]he Allen-Bradley art is not in the same field of endeavor as the claimed subject matter merely because it relates to memories ... [Allen-Bradley] involves memory circuits in which modules of varying sizes may be added or replaced; in contrast, the subject patents teach compact modular memories". *Id.* 1773. In finding substantial evidence to support the jury's finding, the court noted that the Wang SIMMs were pertinent to the field of personal computers, and were designed to provide compact computer memory with minimum size, low cost, easy repairability, and easy expandability. *Id.* 1773. Contrastingly, the Allen-Bradley SIMMs were developed for use in a controller of much larger industrial machinery and could not be used in a personal computer. *Id.* 1773. Thus, while the Wang SIMMs were purposefully designed to be small, size was not a consideration for the Allen-Bradley SIMMs. *Id.* 1773. For these reasons, the court held, the Allen-Bradley prior art was non-analogous and not reasonably pertinent to the '605 and '513 patents. *Id.* 1773.

The test set forth in *In re Clay* was also tellingly applied, for example, in *In re Oetiker*, which is cited by and discussed in MPEP §2141.01(a) in the context of determining analogousness in the mechanical arts. *In re Oetiker*, 24 USPQ2d 1443 (Fed. Cir. 1992). In *In re Oetiker*, an improvement was claimed to a stepless, earless metal clamp, with the improvement being a preassembly hook which serves to both maintain a preassembly condition of the clamp and to disengage automatically when the clamp is tightened. *Id.* 1445. All claims were rejected over the combination of U.S. Patent No. 4,492,004 to Oetiker, which disclosed the unimproved clamp, and U.S. Patent No. 3,426,400 to Lauro, which disclosed a plastic hook and eye fastener for use in garments. *Id.* 1445.

Oetiker argued during prosecution that Lauro's garment hook was non-analogous art in that a person of ordinary skill seeking to solve the problem facing Oetiker would not look to the garment art for the solution. *Id.* 1445. The Examiner argued that because garments commonly use hooks for securement, a person faced with the problem of unreliable maintenance of the pre-assembly configuration of an assembly line metal hose

clamp would look to the garment industry art. *Id.* 1445. On Appeal, the Board held that Lauro was analogous art because both Lauro's and the Oetiker's inventions relate to "a hooking problem". *Id.* 1445.

The court, however, disagreed, stating that it had not been shown that a person of ordinary skill seeking to solve the problem facing Oetiker would reasonably be expected or motivated to look to fasteners for garments. Furthermore:

The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge cannot come from the applicant's invention itself. *Id.* 1446.

In the present case, according to the Examiner "[i]t would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Browder to provide a vending system using RFID devices for keeping track of the returned thermal seats for more accurate inventory and fee charging purposes, in view of the teaching of Brady".

Browder discloses a portable cushion and raincoat apparatus, wherein the cushion is heatable and the cushion and raincoat are foldable into an associated carrying case. According to Browder:

A resistance electrical wire 15 is wound in a serpentine fashion through the cushion and connected to an electrical power source, such as a battery 16, and through an electrical switch 17 so that a small current through the resistance wire 15 will generate heat to assist in warming the user. Col. 2, lines 14-19.

Thus, Browder uses an internal battery to provide power to an electrical resistance element for heating the cushion, whereas the present invention uses an external magnetic field to provide power to a magnetic-induction element for heating the seat.

Brady discloses a magnetic tape storage media (e.g., a video or audio cassette) having an integral RFID transponder adapted to support such functions or operations as automated sale rental or loan of the media, authentication of the media, indexing of information recorded to the media, enablement/disablement of playback of the media, recording the number of times the media has been played, and inventory.

Applying the criteria of *In re Clay* as interpreted in *Wang Laboratories, Inc.* and *In re Oetiker*, Brady is not in the same field of endeavor as the present invention merely because both broadly relate to the problem of storing information concerning rental items. Just as all memories were not the same in *Wang Laboratories, Inc.*, nor all hooking problems the same in *In re Oetiker*, all information storage problems are not the same in the present case. Brady's magnetic storage media is non-analogous art with regard to the present invention's thermal seats, and they are not made analogous merely because both involve the act of renting. One with ordinary skill in the art of thermal seats and the vending thereof would not reasonably be expected to look to magnetic tape storage media and the rental thereof to solve the problem of information storage. Thus, the Applicant strongly believes that Brady does not meet the criteria set forth in *In re Clay* and is therefore non-analogous art with regard to the present invention.

As a rejection based upon non-analogous art cannot be sustained, the Applicant respectfully asserts that the Examiner's rejections of claims 1, 6, and 12 under 35 U.S.C. §103(a) relying on the teachings of Brady are improper and cannot be sustained.

In response to the Examiner's previous rejections of claim 6 and 12 under 35 U.S.C. §103(a) as being unpatentable over the combined teachings of Browder, Brady, and Inoue or Clothier, the Applicant responds as follows. As previously discussed, Brady is non-analogous art with the regard to the present invention and therefore cannot properly be used in rejecting claims to the present invention. Furthermore, the Examiner has failed to establish the requisite *prima facie* case of obviousness with regard to both Inoue and Clothier as no motivation is given or desirability identified for the combination of teachings proposed by the Examiner in rejecting claims 6 and 12. Additionally, Clothier is non-

analogous art with regard to the present invention. Because the Examiner uses the language Inoue or Clothier it is unclear whether these references are applied in the alternative or together. In count 5 of the Office Action, the Examiner seems to rely on Inoue for the feature of a cushion heated by magnetic-induction and on Clothier for the feature of using RFID technology to control magnetic-induction heating. Thus, the Applicant first discusses Inoue and Clothier separately, as though applied in the alternative, and then discusses the two references as though the Examiner meant to apply both together.

Obviousness, it will be appreciated, can be a problematic basis for rejection because the Examiner, in deciding that a feature is obvious, has benefit of the Applicant's disclosure as a blueprint and guide, whereas one with ordinary skill in the art would have no such guide, in which light even an exceedingly complex solution may seem easy or obvious. Furthermore, once an obviousness rejection has been made, the Applicant is in the exceedingly difficult position of having to prove a negative proposition (i.e., non-obviousness) in order to overcome the rejection. For these reasons, MPEP §2142 places upon the Examiner the initial burden of establishing a *prima facie* case which requires, among other things, that there be identified some motivation or suggestion in the prior art or in the knowledge of one with ordinary skill to modify the reference or to combine reference teachings. If the Examiner fails to establish the requisite *prima facie* case, the rejection is improper and will be overturned. *In re Rijckaert*, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). Only if the Examiner's burden is met does the burden shift to the applicant to provide evidence to refute the rejection.

The Examiner must satisfy three criteria in order to establish the requisite *prima facie* case of obviousness: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine their teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or combination of references) must teach or suggest all the claim limitations. MPEP §706.02(j), citing *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991). Furthermore, "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 23 USPQ2d 1780,

1783-84 (Fed. Cir. 1992); *see also In re Gordon*, 221 USPQ2d 1125, 1127 (Fed. Cir. 1984). Additionally, “if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” MPEP §2143.01.

In meeting this initial burden, the Examiner “cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention” *In re Fine*, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant’s disclosure. *In re Vaeck*, 1442 (Fed. Cir. 1991). Thus, “[m]easuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See e.g., *W. L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 USPQ 303, 313 (Fed. Cir. 1983).

In the present case, neither Browder nor Brady disclose magnetic-induction heating and so the Examiner is forced to rely on either Inoue or Clothier for this feature. According to the Examiner:

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Browder to use induction heatable material for the thermal seats so that it can be heated by an induction heating system without any electrical cord connections to the thermal seats, in view of the teaching of Inoue or Clothier.

Inoue, however, clearly shows an electrical cord for providing power to an onboard HF inverter. Thus, Inoue itself does not support the Examiner’s asserted motivation. Furthermore, as the electrical cord provides power rather than information signals or control signals, the electrical cord cannot be eliminated with use of the RFID technology taught in Brady or Clothier.

Additionally, it is unclear why elimination of electrical cord connections is desirable. None of the cited prior art references indicate this to be a desirable goal. Recall that the

mere fact that a proposed modification can be made is irrelevant unless the prior art suggests the desirability of the proposed modification. *In re Fritch*, 1780, 1783-84. Furthermore, Browder's battery could presumably be made removable for charging if it were desirable not to have an electrical cord connection. Thus, even if it were for some reason desirable to eliminate electrical cord connections, Browder need not be modified to use magnetic-induction heating rather than electrical resistance heating in order to achieve such a goal and therefore the modification cannot be said to be obvious.

As no logical motivation for the proposed combination of teachings exists, and, furthermore, as the prior art does not support the desirability of the proposed modification of Browder, the requisite *prima facie* case of obviousness has not been established with regard to the rejections of claims 6 and 12.

The Examiner suggests that Clothier could be applied in place of Inoue to provide the feature of magnetic-induction heating. Clothier, however, concerns a temperature self-regulating food delivery system which, the Applicant respectfully asserts is non-analogous art with regard to the present invention. Applying the criteria, as set forth above, of *In re Clay* as interpreted in *Wang Laboratories, Inc.* and in *In re Oetiker*, the Applicant believes that Clothier is not in the same field of endeavor as the present invention merely because both broadly relate to the problem of heating. Clothier's disclosure of using RFID-controlled magnetic-induction heating to maintain a desired temperature of a food delivery system cannot and does not preclude the patentability of using magnetic-induction heating, RFID-controlled or otherwise, to heat other objects or devices. Just as all memories were not the same in *Wang Laboratories, Inc.*, nor all hooking problems the same in *In re Oetiker*, all heating problems are not the same in the present case. One with ordinary skill in the art of heating and vending thermal seats would not reasonably be expected to look to mechanisms for maintaining temperatures in food delivery systems for inspiration in solving the problem of heating the seats. Thus, the Applicant strongly believes that Clothier does not meet the criteria set forth in *In re Clay* and is therefore non-analogous art with regard to the present invention.

With regard to the case of applying Inoue and Clothier together, the Applicant responds as follows. As mentioned, Inoue's electrical cord provides power rather than information signals or control signals and therefore the RFID technology of Brady and

Clothier does not result in elimination of the electrical cord. Thus, no motivation to combine exists. Furthermore, whether applied individually or in combination with Inoue, Clothier is still non-analogous art with regard to the present invention and cannot therefore be used to reject under 35 U.S.C. §103 the claims thereto.

Thus, regardless of whether Inoue and Clothier are applied alternatively or together, the requisite *prima facie* case of obviousness has not been established and therefore the rejections of claims 6 and 12 cannot be sustained.

Claims 17-20 are substantially similar to those claims of the parent application indicated by the Examiner to be allowable if rewritten in independent form. The primary difference is the elimination of the requirement that graphite be included in the induction-heatable elements, and the requirement that synthetic resin be included in the heat retentive material. Thus, the Applicant respectfully asserts that claims 17-20 are allowable as well.

As all claims currently pending in the application are in condition for allowance, the Applicant respectfully requests a corresponding Notice of Allowance.

In the event of any questions, the Examiner is urged to call the undersigned at 1-800-445-3460. Any additional fee which might be due in connection with this application should be applied against our Deposit Account No. 19-0522.

Respectfully Submitted,

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